UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

MAILED

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**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

*Ex parte BERNARD A. WEINSTEIN,
STEVEN BONGIOVANNI,*
and
KEVIN J. FLYNN

Appeal No. 2002-0719
Application No. 08/863,037

ON BRIEF

Before KRATZ, TIMM, and MOORE, *Administrative Patent Judges.*

MOORE, *Administrative Patent Judge.*

REMAND TO THE EXAMINER

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the examiner to consider the following issues and to take appropriate action.

REPRESENTATIVE CLAIM

Claim 1 is representative of the claims on appeal, and reads as reproduced below.

1. A system for providing notification of market information, which comprises:

a user computer for specifying a market condition to be monitored and a corresponding client ID;

an electronic source of updated market data;

a host computer system for receiving and storing a plurality of the market conditions specified for monitoring and the corresponding client IDs;

confirmation data generated and transmitted by said host computer system upon receipt of the specified market condition to be monitored and the corresponding client ID, said confirmation data indicating that the specified market condition has been received by said host computer and will be monitored;

a monitoring program executable on said host computer system for comparing each of said specified market conditions stored on said host computer system and said source of updated market data, to determine if a specified market condition is found in said source of updated market data, said monitoring program generating a signal if a specified market condition is found to exist, the signal indicative of the found specified market condition and the corresponding client ID stored on said host computer system; and

a transmitter responsive to said signal for transmitting notification of the specified market condition.

The References

In rejecting the claims under 35 U.S.C. § 103(a), the

examiner relies upon the following references:

Higgins	5,270,922	Dec. 14, 1993
Vanden Huevel et al. (Vanden Huevel)	5,281,962	Jan. 25, 1994
Potter et al. (Potter)	5,787,402	Jul. 28, 1998

We cite the following additional references:

Wiseman   5,168,446   Dec. 01, 1992

Cannon et al. (Cannon)   5,423,086   Jun. 06, 1995

The Rejections

Claims 1-2, 4, 11-12, and 14-17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Potter in view of Higgins.

Claims 3 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Potter and Higgins, as applied to claims 1 and 11, further in view of Vanden Huevel.

The Invention

The invention relates to a system for providing market information to a user. A user computer is utilized to specify a market condition to be watched, a server confirms receipt of the watch request. The server runs software, which compares the watch request to updated market data. When the market condition is found to exist (i.e. IBM at 100), the user is notified, in a preferred embodiment by email. See claims 1 and 3, reproduced above, for further details of the claimed invention.

I. The Rejection of Claims 1-2, 4, 11-12, and 14-17 under
35 U.S.C. §103(a) as being unpatentable over Potter in view of
Higgins

The examiner has found that Potter teaches a method and

system for performing automated financial transactions involving

foreign currencies which comprises a user computer for specifying

a market condition to be monitored and a corresponding client ID;

an electronic source of market data; a host computer system

including a database for receiving and storing a plurality of the

market conditions specified for monitoring and the corresponding

client IDs; confirmation data generated and transmitted by said

host computer system upon receipt of the specified market

condition and corresponding client ID by said database; said

confirmation data indicating that the specified market condition

has been received by the host computer and will be monitored, and

a transmitter responsive to said signal for transmitting

notification of the specified market condition. (Examiner's

Answer, paragraph numbered 2, spanning pages 3 and 4).

The examiner has additionally found that Higgins teaches a

system for distributing, processing, and displaying financial

information which comprises a monitoring program executable on

the host computer system for comparing each of the specified

market conditions stored on a host computer system to a source

for updated market data to determine if a specified market

condition is found in a source of updated market data, the

program generating a signal if the condition is found to exist,

for the purpose of communicating and displaying information to

brokers, investors, and others concerned with financial markets.

(Examiner's Answer, paragraph numbered 4, spanning pages 4 and

5).

The examiner thus concludes that it would have been obvious

to one of ordinary skill in the art at the time the invention was

made to have included an updated source of electronic market data

and a monitoring system on a host computer to compare data and

determine if a market condition exists, the monitoring system

generating a signal, for the purpose of providing information to

those concerned with financial markets (Examiner's Answer,

paragraph numbered 5, page number 5).

The appellants, on the other hand, argue that all three

independent claims call for a system for providing notification

of market information in which a user computer is used to specify

a market condition to be monitored, which specified market

condition is stored upon a host computer. Upon receipt of the

condition to be monitored, the host computer generates and

transmits a confirmation. The monitoring program compares the

specified market conditions and the source of market data, when a

specified market condition is found to exist, the monitoring

program generates and transmits a signal (Appeal Brief, page 5,
lines 6-17).

The appellants additionally urge that Potter teaches sending
confirmation only after the user's desired terms are found to
exist, whereas the instant claims are said to require two
separate signals to be sent if the market condition is found to
exist. (Appeal Brief, page 6, lines 6-23).

In response, the examiner asserts that "When using computer
to computer transactions, and a given market condition is
requested to be monitored by a consumer, it would have been
obvious to the skilled artisan to also submit a confirmation
notice to the consumer to ascertain that the correct market and
parameters associated with the consumer's preference data are the
ones being monitored. A motivation would have been to prevent
the wrong market condition to be monitored which may cause a
catastophical [sic] and damaging impact on both the consumer and
the financial firm. (Examiner's Answer, page 7, lines 7).

The appellants have not responded to this assertion in the
examiner's answer.

The examiner further asserts that the claims do not specify
when confirmation exists, or that the signal be separated from
the confirmation data. (Examiner's Answer, page 7, lines 16-19).

6

It is by now well understood that it is an applicants' claims which define the subject matter for which they seek protection. United Carbon Co. v. Binney & Smith Co., 317 U.S. 228, 232, 55 USPQ 381, 383-384 (1942) (citing General Electric Co. v. Wabash Appliance Corp., 304 U.S. 364, 369, 37 USPQ 466, 468-469 (1938); In re Zletz, 893 F.2d 319, 321, 322, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989); SRI Int'l. v. Matsushita Elec. Corp., 775 F.2d 1107, 1121, 227 USPQ 577, 586 (Fed. Cir. 1985) (en banc). Thus, we begin our review by determining what is the scope and content of appellants' claims here on appeal.

First, we note that we disagree with the examiner's interpretation of the claims. Claim 1 requires that confirmation data is generated and transmitted by the host computer upon receipt of the specified market condition. This is directly contrary to the examiner's interpretation that such data could be "immediately upon receipt or later … after trade." (Examiner's Answer, page 7, line 17). Accordingly, we conclude that an immediate confirmation is required by the claims on appeal.

Second, we note that there are conflicting viewpoints regarding the Potter reference advanced in the examiner's answer. First, in the rejection, it is stated that Potter discloses "…confirmation data generated and transmitted by said host computer system upon receipt of the specified market condition

and corresponding client ID by said database." (Examiner's Answer, page 4, lines 1-3). We note that this statement is without any citation to the record for support (although the Final Rejection, paper #12, page 4, lines 1-2 implies support can be found at column 3, lines 1-11 and 37-42; we have found no evidence supporting this contention there).

Then in responding to the appellants' argument, it is asserted that "it would have been obvious to the skilled artisan to also submit a confirmation notice to the consumer to ascertain that the correct market and parameters associated with the consumer's preference data are the ones being monitored." (Examiner's Answer, page 7, lines 2-5).

We, therefore, are unsure if the examiner has abandoned his earlier position, has modified it, or is maintaining it. We are constrained to remand this application, if for no other reason than to clarify these conflicting statements.

Furthermore, our independent review of Potter reveals that it discloses a system that currency trading customers can access from their personal computer. (Column 3, lines 15-22). The system, automatically accepts, monitors, and executes so-called "leave" orders (column 3, lines 48-50). The customer has a user name (ID; column 5, lines 50-60) and password, which is used to log into a central server system (column 4, lines 60-65). A

8

client making a leave order for forward trading (column 12, lines 19-25) is presented with an FX order blotter, which summarizes placed orders (column 12, lines 30-35).

In the leave order Management Mode, for an Order Entry or Order Management user, the client may cancel a leave order at any time (column 12, lines 45-58). To determine whether an order will autoexecute, a user can assign an Active order the attributes of either notify or autoexecute, or both. (Column 14, lines 9-12). When the order information is entered, the order blotter displays the information, then sends it to the FX order server. (Column 13, lines 44-50). The Order Blotter also has an edit mode to edit pending orders. (Column 13, lines 51-54). The FX order server transmits audio and visual warnings of the market conditions received from a Rate server, and as the pricing gets within 3% then 1% of the desired condition (column 14, lines 14-21).

In plain language, what this appears to mean is that a user of this system (a novice or professional trader) has a user computer and ID for monitoring a market condition (rates) for potential pending trades. The user receives a message confirming the monitoring in the form of pending trades or notifications on the FX order blotter simultaneously with sending it to the FX order database. When the rate server (electronic source of

9

updated market data) indicates the rate is getting close, it

transmits audio and visual signals notifying the specified market

condition.

Accordingly, we additionally remand this application to the

examiner for consideration of whether the newly cited portions of

Potter render the claimed subject matter obvious, or even

anticipated, in accord with current examination policy and

procedure.

Finally, in our review of the prior art, we uncovered

Wiseman, US 5,168,446. At column 4, lines 5-10, we note that

Wiseman teaches confirming pending trades, when the trades fall

outside certain limitations. It seems to us that this might

provide some additional evidentiary support for avoiding

financial catastrophe in a similar system by confirming data.

Furthermore, Cannon, US 5,423,086, discloses e-mail as a

convenient way of receiving stock quotes from a server (column 1,

lines 31-38). The examiner is therefore directed to additionally

consider these references.

APPROPRIATE ACTION

Accordingly, the subject application is being returned to the jurisdiction of the examiner, via the office of a Director of the Technology Center involved, for:

1) Clarification of the examiner's position vis-à-vis the disclosure of Potter concerning notification of the market condition to be monitored;

2) Consideration, in a manner consistent with current examination practice and procedure, of whether the newly-cited portions of Potter anticipate or would have rendered obvious, the claimed subject matter; and

3) Consideration, in a manner consistent with current examination practice and procedure, of the two additional references provided herewith, and whether they, in conjunction with the art already of record, further render the claimed subject matter unpatentable.

We remand this application to the examiner for further treatment consistent with the above discussion.

We state that we are not authorizing a Supplemental Examiner's Answer under 37 CFR § 1.193(b)(1).

This application, by virtue of its "special" status, requires an immediate action. Manual of Patent Examining Procedure § 708.01 (7th ed., rev. 1, February 2000). It is

Appeal No. 2002-0719
Application No. 08/863,037

important that the Board be informed promptly of any action

affecting the appeal in this case.

REMANDED

PETER F. KRATZ   )
Administrative Patent Judge   )
)
)
) BOARD OF PATENT
CATHERINE TIMM   )
Administrative Patent Judge   )   APPEALS AND
)
) INTERFERENCES
)
JAMES T. MOORE   )
Administrative Patent Judge   )

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12

Appeal No. 2002-0719
Application No. 08/863,037

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